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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 10/782,083  
Filing Date: February 19, 2004  
Appellant(s): RAO, BINDU RAMA

\_\_\_\_\_  
Patrick G. Billig (Reg. No. 38,080)  
For Appellant

#### EXAMINER'S ANSWER

1. This is in response to the appeal brief filed December 9, 2008 appealing from the Office action mailed July 15, 2008.

#### Real Party in Interest

2. The appellants' statement identifying the real party in interest contained in the brief is correct.

#### Related Appeals and Interferences

3. The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

#### Status of Claims

4. The appellants' statement of the status of claims contained in the brief is correct.

#### Status of Amendments

5. The appellants' statement of the status of amendments contained in the brief is substantially correct except that the Final Office Action was mailed July 15, 2008.

#### Summary of Claimed Subject Matter

6. The appellants' summary of claimed subject matter contained in the brief is correct.

#### Grounds of Rejection to be Reviewed on Appeal

7. The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

#### Claims Appendix

8. The appellants' copy of the appealed claims contained in the Appendix to the brief is substantially correct except for the term "gracefully" which has been deleted from independent claims 1, 13, 19, and 42 in the amendment filed May 5, 2008.

#### Evidence Relied Upon

6,842,783	Boivie et al.	1-2005
6,952,714	Peart	10-2005
6,959,327	Vogl et al.	10-2005

#### Grounds of Rejection

9. The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-6, 8-11, 19-21, 23-31, 35-36, 38, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boivie et al. (US 6,842,783) in view of Peart (US 6,952,714).

**INDEPENDENT:**

As per claim 1, Boivie teaches a method of managing incoming access requests during an update event from a plurality of electronic devices in a communication network, each of the incoming access requests comprising at least one update-related parameter, the method comprising:

receiving each incoming access request at least temporarily (see col.5, lines 20-21: "requests arrive at a Communication Bandwidth Manager (CBM) 110");

determining the availability of at least one device server to process the incoming access requests (see col.5, lines 25-28: "selects one of the servers 101"; and col.6, lines 28-30: "selects a Web server node 101 (e.g. based on a determination made by a conventional load balancer or the like which selects one node over another) to service the request");

immediately processing incoming access requests upon determining that the at least one device server is available (see col.5, lines 29-31: "The selected server receives the Web request, services it... "); and

communicating at least one message to electronic devices requesting access upon determining that the at least one device server is unavailable (see col.6, lines 47-50: "return a message to the Web client 130 that the server complex is overloaded").

Boivie does not explicitly teach monitoring and evaluating the incoming access requests using the at least one update-related parameter wherein determining step is based upon the at least one update-related parameter.

Peart teaches monitoring and evaluating the incoming access requests using the at least one update-related parameter wherein determining step is based upon the at least one update-related parameter (see col.30, lines 30-36: "the parameter identifying the selected data file is provided directly to the server node, which contacts the web site directly for data associated with the selected file").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie in view of Peart by implementing monitoring and evaluating the incoming access requests using the at least one update-related parameter wherein determining step is based upon the at least one update-related parameter. One would be motivated to do so because this would allow the request to reach the appropriate destination to be serviced.

As per claim 19, Boivie teaches an electronic device network adapted to manage incoming access requests during an update event, each of the incoming access requests comprising at least one update-related parameter, the electronic device network comprising:

at least one electronic device having one of software and firmware, the electronic device being adapted to be communicatively coupled to the electronic device network (see Fig.1);

an access control unit (see Fig.3 and col.7, lines 1-7);

at least one device server operatively coupled to the access control unit (see Fig.1); and

a memory operatively coupled to the at least one device server (see col.5, lines 44-47), wherein the access control unit is adapted to immediately process and manage incoming information access requests from the at least one electronic device (see col.25-28 and col.7, lines 10-17: "... and determines the server node 011 to service the request"), wherein the access control unit is adapted to determine an incoming access request volume at the at least one device server and ability of the at least one device server to service additional incoming access requests (see col.5, lines 25-28: "selects on of the servers 101"; and col.6, lines 28-30: "selects a Web server node 101 (e.g. based on a determination made by a conventional load balancer or the like which selects one node over another) to service the request").

Boivie does not explicitly teach that the electronic device is a mobile device.

Peart teaches of a mobile device (see col.4, lines 29-32: "wireless device")

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie in view of Peart so that electronic device is a mobile device. One would be motivated to do so because mobile device are one of plurality of devices that request for service via the Web.

As per claim 42, Boivie teaches a method of managing incoming access requests during an update event from a plurality of electronic devices in a communication network, each of the incoming access requests comprising at least one selection-related parameter, the method comprising:

receiving each incoming access request at least temporarily (see col.5, lines 20-21: "requests arrive at a Communication Bandwidth Manager (CBM) 110");

determining whether the incoming access requests is able to be processed (see col.5, lines 25-28: "selects on of the servers 101"; and col.6, lines 28-30: "selects a Web server node 101 (e.g. based on a determination made by a conventional load balancer or the like which selects one node over another) to service the request");

immediately processing incoming access requests upon determining that processing the incoming access request is likely to be successful (see col.5, lines 29-31: "The selected server receives the Web request, services it... "); and

communicating at least one message to the electronic device requesting access upon determining that processing the incoming access request is unlikely to be successful (see col.6, lines 47-50: "return a message to the Web client 130 that the server complex is overloaded").

Boivie does not explicitly teach monitoring and evaluating the incoming access requests using the at least one update-related parameter wherein determining step is based upon the at least one update-related parameter.



Peart teaches monitoring and evaluating the incoming access requests using the at least one update-related parameter wherein determining step is based upon the at least one update-related parameter (see col.30, lines 30-36: "the parameter identifying the selected data file is provided directly to the server node, which contacts the web site directly for data associated with the selected file").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie in view of Peart by implementing monitoring and evaluating the incoming access requests using the at least one update-related parameter wherein determining step is based upon the at least one update-related parameter. One would be motivated to do so because this would allow the request to reach the appropriate destination to be serviced.

**DEPENDENT:**

As per claim 3, which depends on claim 1, Boivie further teaches wherein the at least one update-related parameter comprises at least one of device identification information, firmware identification information, software identification information, and information regarding other resources available in the electronic device (see col.4, lines 42-44).

As per claim 4, which depends on claim 1, Boivie further teaches wherein the at least one message comprises a denial of service message (see col.6, lines 47-56).

As per claim 5, which depends on claim 4, Boivie further teaches wherein the denial of service message comprises at least one reason for service denial (see col.6, lines 47-56).

As per claim 6, which depends on claim 1, Boivie further teaches wherein determining the availability of the at least one device server to process the incoming access requests comprises evaluating at least one of an expected volume of requests, collected statistical information, user profile, request profile, and heuristics (see col.7, lines 10-17).

As per claim 8, which depends on claim 1, Boivie further teaches wherein monitoring and evaluating the incoming access requests further comprises periodically retrieving a status information communication from one of the at least one device server and at least one of the plurality of electronic devices (see col.6, lines 15-19).

As per claim 9, which depends on claim 1, Boivie further teaches wherein monitoring and evaluating the incoming access requests further comprises monitoring at least one network resource, operational status of the at least one device server, a volume of incoming access requests, and information regarding at least one of the plurality of electronic devices (see col.6, line 15-19).

As per claim 10, which depends on claim 1, Boivie teaches comprising selecting a candidate device server to process an incoming access request based upon monitored information regarding the at least one device server (see col.6, lines 20-32).

As per claims 11 and 20, which respectively depend on claims 1 and 20, Boivie does not explicitly teach wherein the at least one electronic device comprises a plurality

of mobile electronic devices, and wherein the plurality of mobile electronic devices comprise at least one of a mobile cellular phone handset, personal digital assistant, pager, MP3 player, and a digital camera.

Peart teaches of a mobile device (see col.4, lines 29-32: "wireless device")

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie in view of Peart so that electronic device is a mobile device. One would be motivated to do so because mobile device are one of plurality of devices that request for service via the Web.

As per claim 21, which depends on claim 19, Boivie does not explicitly teach wherein the at least one device server comprises a plurality of device servers adapted to dispense updates to a plurality of update requesting electronic devices.

Peart teaches a plurality of device servers adapted to dispense updates to a plurality of update requesting electronic devices (see col.21, lines 20-24).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie in view of Peart by implementing a plurality of device servers adapted to dispense updates to a plurality of update requesting electronic devices. One would be motivated to do so because software updates are one or plurality of services provided by Web server.

As per claim 23, which depends on claim 19, Boivie further teaches further comprising a monitoring unit adapted to monitor activity of the at least one device server (see col.6, lines 20-32).

As per claim 24, which depends on claim 19, although Boivie further teaches a memory, Boivie does not explicitly teach comprising a plurality of updates retrievable by the at least one device server.

Peart teaches a plurality of updates retrievable by the at least one device server (see col.21, lines 20-24).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie in view of Peart by implementing a plurality of updates retrievable by the at least one device server. One would be motivated to do so because software updates are one or plurality of services provided by Web server.

As per claim 25, which depends on claim 19, Peart further teaches wherein the at least one mobile electronic device comprises random access memory and non-volatile memory, and wherein the non-volatile memory comprises at least one of an update application loader, update agent, download agent, and an operating system (inherency).

As per claim 26, which depends on claim 19, Boivie further teaches wherein an incoming access request comprises at least one of device identification information, firmware identification information, software version information, and resource availability information (see col.4, lines 42-44).

As per claim 27, which depends on claim 19, Boivie further teaches wherein the access control unit is adapted to determine priority of an incoming access request by

recognizing that the incoming access request is one of a repeated and rescheduled access request (see col.4, lines 40-41 and col.5, lines 44-57).

As per claim 28, which depends on claim 19, Boivie further teaches wherein the access control unit is adapted to determine one of whether a particular incoming access request requires immediate processing, whether the incoming access request requires deferment, and whether the incoming access request requires denial based upon operational status information gathered by monitoring the at least one device server and by evaluating the incoming access request (see col.5, lines 44-57).

As per claim 29, which depends on claim 28, Boivie further teaches wherein upon determining that the incoming access request requires denial, the access control unit communicates at least one message to the mobile electronic device (see col.6, lines 47-56).

As per claim 30, which depends on claim 29, Boivie further teaches wherein the at least one message to the mobile electronic device comprises a denial of service message (see col.6, lines 47-56).

As per claim 31, which depends on claim 29, Boivie further teaches wherein the at least one message to the mobile electronic device comprises at least one reason for service denial (see col.6, lines 47-56).

As per claim 35, which depends on claim 29, Boivie further teaches wherein a rescheduled request is rapidly advanced in the processing queue (see col.4, lines 40-41).

As per claim 36, which depends on claim 28, Boivie further teaches wherein upon determining that the incoming access request requires denial, a denial of service message is displayed at the mobile electronic device (see col.6, lines 47-56).

As per claim 38, which depends on claim 27, Boivie further teaches wherein the access control unit is adapted to at least briefly accept all incoming communications (implicit: see col.6, lines 8-11).

As per claim 40, which depends on claim 19, Boivie and Peart further teach wherein the mobile electronic devices are adapted to one of: repeat denied access requests without end-user intervention (see col.6, lines 63-64); prompt an end-user to initiate repeated access requests; display alternative schedules communicated to the mobile electronic device; prompt the end-user to select a particular alternative schedule; and autonomously repeat the access request according to a selected alternative schedule.

As per claim 41, which depends on claim 19, Boivie further teaches wherein the at least one update-related parameter comprises at least one of device identification information, firmware identification information, software identification information, and information regarding other resources available in the electronic device (see col.4, lines 42-44).

As per claim 43, which depends on claim 42, Boivie further teaches wherein the at least one message communicated to electronic device comprises schedule information useable by the electronic device to re-attempt access employing another incoming access request (see col.6, lines 63-64).

11. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boivie et al. (US 6,842,783) in view of Vogl et al. (US 6,959,327).

As per claim 13, Boivie teaches a method of managing incoming access requests during an update event from a plurality of electronic devices in a mobile electronic network, the method comprising:

recognizing that an incoming access request is a access request (see col.5, lines 20-28); and

fulfilling the access request with higher priority than an original request (subjective: see col.4, lines 40-41: "incoming requests are served by priority" and col.5, lines 44-57).

Boivie does not explicitly teach evaluating the incoming access requests, the incoming access requests at least comprising at least one update-related parameter and wherein the request is a rescheduled access request.

Vogl teaches evaluating the incoming access requests, the incoming access requests at least comprising at least one update-related parameter (see Fig.7 and col.15, line 63- col.16, line 2: "which instructs the schedule architecture 800 to retrieve...") and wherein the request is a rescheduled access request (see col.15, lines 17-22).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie in view of Vogl by implementing evaluating the incoming access requests, the incoming access requests at least

comprising at least one update-related parameter and wherein the request is a rescheduled access request. One would be motivated to do so because this would allow the request to reach the appropriate destination to be serviced and allow requests to be received when system can efficiently handle the request.

As per claim 14, which depends on claim 13, Boivie further teaches wherein the rescheduled access request is an incoming access request that was previously denied (see col.47-56).

As per claim 15, which depends on claim 13, Boivie further teaches wherein fulfilling the rescheduled access request with higher priority than an original request comprises advancing the rescheduled request in a processing queue (see col.4, lines 40-41).

As per claim 16, which depends on claim 13, Boivie further teaches wherein fulfilling the rescheduled access request with higher priority than an original request comprises immediately placing the rescheduled request in the processing queue (see col.5, lines 44-57).

As per claim 17, which depends on claim 13, Boivie does not explicitly teach wherein the at least one mobile electronic device comprises a plurality of electronic devices, and wherein the plurality of electronic devices comprise at least one of a mobile cellular phone handset, personal digital assistant, pager, MP3 player, and a digital camera.

Vogl teaches of a mobile device (implicit: see col.6, lines 27-33: "wireless networks")



It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie in view of Vogl so that electronic device is a mobile device. One would be motivated to do so because mobile device are one of plurality of devices that request for service via the Web.

As per claim 18, which depends on claim 13, Boivie further teaches wherein the at least one update-related parameter comprises at least one of device identification information, firmware identification information, software identification information, and information regarding other resources available in the electronic device (see col.4, lines 42-44).

12. Claims 2, 7, 12, 32-43, 37, 39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boivie et al. (US 6,842,783) and Peart (US 6,952,714), and further in view of Vogl et al. (US 6,959,327).

As per claim 2, which depends on claim 1, Boivie and Peart do not explicitly teach wherein communicating comprises determining at least one alternate schedule for the electronic device to send a rescheduled access request upon determining that the at least one device server is unavailable for processing, based upon the at least one update-related parameter.

Vogl teaches determining at least one alternate schedule for the electronic device to send a rescheduled access request upon determining that the at least one device server is unavailable for processing (see col.3, lines 22-25), based upon the at least one update-related parameter (see Fig.7 and col.15, line 63- col.16, line 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie and Peart in view of Vogl by implementing determining at least one alternate schedule for the electronic device to send a rescheduled access request upon determining that the at least one device server is unavailable for processing. One would be motivated to do so because this would notify the electronic device to submit a request when system can efficiently handle the request.

As per claim 7, which depends on claim 1, although Boivie teaches an explanatory denial of service message (see col.6, lines 50-52), Boivie and Peart do not explicitly teach further comprising graceful communication termination, wherein graceful communication termination comprises communicating an alternate schedule to send a rescheduled access request.

Vogl teaches communicating an alternate schedule to send a rescheduled access request (see claim 2 rejection above)

As per claim 12, which depends on claim 1, Boivie and Peart do not explicitly teach wherein the at least one message comprises alternate schedule information, wherein the alternate schedule information comprises at least one of a time to re-submit an access request, a particularly time frame for re-submitting an access request, an amount of time that must elapse before re-submitting and access request, and a particular date for re-submitting an access request.

Vogl teaches an alternate schedule information comprises at least one of a time to re-submit an access request, a particularly time frame for re-submitting an access

request, an amount of time that must elapse before re-submitting and access request, and a particular date for re-submitting an access request (see claim 2 rejection above).

As per claim 32, which depends on claim 29, Boivie and Peart do not explicitly teach wherein upon determining that the incoming access request requires denial, the access control unit is adapted to determine at least one alternate schedule for the mobile electronic device to send a rescheduled access request.

Vogl teaches upon determining that the incoming access request requires denial, the access control unit is adapted to determine at least one alternate schedule for the mobile electronic device to send a rescheduled access request (see claim 2 rejection above).

As per claim 33, which depends on claim 29, Boivie and Peart do not explicitly teach wherein upon determining that the incoming access request requires denial, the access control unit is adapted to communicate at least one alternate schedule to the mobile electronic device along with the at least one message.

Vogl teaches upon determining that the incoming access request requires denial, the access control unit is adapted to communicate at least one alternate schedule to the mobile electronic device along with the at least one message (see claim 2 rejection above).

As per claim 34, which depends on claim 29, although Boivie and Peart teaches the rescheduled access request is determined to have higher priority than an original incoming access request, and wherein the rescheduled access request is one of immediately placed in the processing queue and advanced in the processing queue

(subjective see claim 13 rejection above), Boivie and Peart do not explicitly teach wherein a rescheduled access request is an incoming access request that was previously denied service.

Vogl teaches wherein a rescheduled access request is an incoming access request that was previously denied service (see claim 2 rejection above).

As per claim 37, which depends on claim 28, Boivie and Peart does not explicitly teach wherein upon determining that the incoming access request requires denial, a message comprising instructions for re-attempting the denied access request at one of a specific time and after a period of time has elapsed and an explanatory message is displayed at the mobile electronic device.

Vogl teaches wherein upon determining that the incoming access request requires denial, a message comprising instructions for re-attempting the denied access request at one of a specific time and after a period of time has elapsed (see col.3, lines 9-10) and an explanatory message is displayed at the mobile electronic device (see col.7, lines 19-23).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Boivie and Peart in view of Vogl by implementing wherein upon determining that the incoming access request requires denial, a message comprising instructions for re-attempting the denied access request at one of a specific time and after a period of time has elapsed and an explanatory message is displayed at the mobile electronic device. One would be motivated to do so because Boivie teaches that by default browsers will retransmit requests when the

browser cannot obtain a response. Therefore, by implementing such means, the control is given to the user and/or electronic device.

As per claim 39, which depends on claim 19, although Boivie and Peart teach further comprising a monitoring unit, the monitoring unit being adapted to gracefully manage denial of service for incoming access requests by: monitoring a volume of incoming access requests (see col.5, lines 22-28); determining device server availability (see col.6, lines 47-56); and providing monitored information to the access control unit (see col.6, lines 1-19), Boivie and Peart do not teach determining alternative schedules for mobile electronic devices to re-attempt access requests; and communicating the alternative schedules to the mobile electronic devices.

Vogl teaches determining alternative schedules for mobile electronic devices to re-attempt access requests; and communicating the alternative schedules to the mobile electronic devices (see claim 2 rejection above).

As per claim 44, which depends on claim 42, Boivie and Peart does not explicitly teach wherein the at least one message communicated to electronic device comprises a schedule information indicating a time when the communication network is likely to be able to provide one of requested information and data to the electronic device.

Vogl teaches wherein the at least one message communicated to electronic device comprises a schedule information indicating a time when the communication network is likely to be able to provide one of requested information and data to the electronic device (see claim 2 rejection above).

Response to Argument

13. The examiner summarizes the various points raised by the appellant and addresses replies individually.

14. As per appellants' arguments filed December 9 2008, the appellant(s) argue in substance:

(a) That the limitations of independent claim 1, specifically, "monitoring and evaluation the incoming access requests using that at least one update-related parameter" is not, alone or in combination, disclosed, taught, or suggested by Boivie or Peart (see Appeal Brief, pages 7-9).

In response to (a), Peart is relied upon to teach this missing limitation. The examiner agrees that Peart in column 29, lines 55-58 suggests a direction of traffic that is opposite in direction than what is suggested from the recited claim language. However, Peart suggests numerous scenarios and alternatives which clearly teach and suggest the above recited limitation. Peart teaches in column 30, lines 30-36, that the "parameter identifying the selected data file" is provided to the server from the client such that the server forwards the requests for the file directly to the web site.

Furthermore, in response to the argument that the examiner equates any parameter to an update parameter, the argument is flawed in two respects. Firstly, the "parameter" relied on by the appellant(s) is not associated with an update parameter, but rather an "update-related parameter". Secondly, Peart teaches throughout that the

system is applicable to mapping updates (see col.22, lines 40-48; col.27, lines 58-61; and col.31, lines 45-48), therefore any parameter taught by Peart is in fact related to updates, and hence this limitation is clearly and explicitly taught by Peart.

(b) That claims 3-6 and 8-11, for the reasons with respect to claim 1 and by virtue of their dependency to claim 1, are also patentably distinguishable from the combination of Boivie and Peart (see Appeal Brief, page 9).

In response to (b), since it has been shown above that Peart clearly and explicitly teaches the missing limitation of claim 1 and the combined teaching of Boivie and Peart teach all the limitations of claim 1, 3-6 and 8-11 in the rejection set forth above.

(c) That independent claim 19, for the reasons with respect to independent claim 1, is patentably distinguishable from the combination of Boivie and Peart and claims 20, 21, 23-31, 35, 36, 38, 40, and 41 by virtue of their dependency to claim 19, are also patentably distinguishable from the combination of Boivie and Peart (see Appeal Brief, pages 9-10).

In response to (c), see In response to (a).

(d) That independent claim 42, for the reasons with respect to independent claim 1, is patentably distinguishable from the combination of Boivie and Peart and claim 43 by virtue of its dependency to claim 42, is also patentably distinguishable from the combination of Boivie and Peart (see Appeal Brief, page 10).

In response to (d), see In response to (a).

(e) That the combination of references are improper for the reason that they are not applicable, they are non-analogous art, they are not in the same field of endeavor, and do not solve a pertinent problem (see Appeal Brief, pages 10-15)

In response to (e), since it has been established that Peart explicitly teaches a request in the appropriate direction (ie. to the server), it is clear as to the applicability of Peart to Boivie.

In response to applicant's argument that Boivie and Peart are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Boivie teaches of meeting service level agreement (SLA) such that a server is selected to process incoming requests, which is clearly in the field of the appellant(s) endeavor. Peart teaches selecting a data file, locating the data file, and



executing the data file (i.e. client-server architecture), which is clearly pertinent to the problem of finding "at least one device server to process the incoming access request".

In response to applicant's argument that Boivie and Peart are not pertinent to the problem, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Clearly both systems of Boivie and Peart are capable of finding a server to service the request for a software update. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (ie., "software updates" see Appeal Brief, pages 13-15) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to

effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396.

Accordingly, since the applicant(s) have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

(f) That the rejection of claims 1, 3-6, 8-11, 19-21, 23-31, 35, 36, 38, and 40-44 should be removed because the references are combined based on improper hindsight reasoning (see Appeal Brief, page 15).

In response to (f), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Clearly, one of ordinary skill in the art would

incorporate adding and processing any parameter in the incoming request such that the request can be directed to the appropriate server to service the request.

(g) That the rejection of claims 13-18 should be removed because the references are combined based on improper hindsight reasoning (see Appeal Brief, page 15).

In response to (g), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Clearly, one of ordinary skill in the art would incorporate a reschedule means because sometimes servers are overloaded or unavailable and cannot service requests.

(h) That the rejection of claims 2, 7, 12, 32-34, 37, 39, and 44 should be removed because the references are combined based on improper hindsight reasoning (see Appeal Brief, pages 15-17).

In response to (h), see In response to (g).

Related Proceeding(s) Appendix

15. There are no copies of any decisions rendered by a court or the Board in any proceedings.
16. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michael Won/

Primary Examiner

February 18, 2009

CONFEREES:

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